

REMARKS

I. Status of the Claims

Claims 30-39 and 42-67 are pending in this application. No claims have been added or amended by this Response. Applicants would like to thank the Examiner for withdrawing the previous grounds of rejection under 35 U.S.C. § 112, second paragraph, 35 U.S.C. § 102, and the obviousness-type double patenting rejection.

II. Rejections Under 35 U.S.C. § 103(a)

A. Kumar in view of Janchitraponvej

The Examiner has maintained the rejection over claims 30-39 and 42-67 under 35 U.S.C. § 103(a) as unpatentable over WO 93/23009 to Kumar et al. ("Kumar") in view of U.S. Patent No. 5,417,965 to Janchitraponvej et al. ("Janchitraponvej").

The Examiner asserts that Kumar teaches skin care and hair care compositions comprising the presently claimed at least one grafted silicone and alleges that Kumar's silicone polymer can be used in conjunction with conventional polymers such as anionic, cationic, and amphoteric polymers. Final Office Action, p. 2. The Examiner admits, however, that Kumar fails to teach the presently claimed at least one aqueous dispersion of insoluble particles of at least one cationic polymer recited in the present claims. *Id.*

To supply this missing disclosure, the Examiner relies on the teachings of Janchitraponvej. Specifically, the Examiner contends that it would have been obvious to add "the water-insoluble dispersion containing cationic acrylate/acrylamide polymer of [Janchitraponvej] to the vinyl-silicone hair composition of [Kumar], because [Janchitraponvej] suggests that the combination of cationic polymers, polyethyleneimine

and acrylate/acrylamide provides excellent cleansing of hair while still providing high foaming and conditioning of the hair.” *Id.* Applicants respectfully disagree for reasons of record, as well as for the additional reasons set forth below.

In making a rejection under 35 U.S.C. § 103, the Examiner carries the initial burden of establishing a prima facie case of obviousness. In so doing, the Examiner must point to some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. M.P.E.P. § 2143. In the present case, Applicants respectfully submit that the Examiner has merely picked various ingredients from the prior art references without considering each reference as a whole, as required by the M.P.E.P. Moreover, the Examiner has not properly identified any “clear and particular” evidence of motivation for the combination of references as required by the relevant case law. *See, e.g., In re Dembiczak* 175 F.3d 994, 999 (Fed. Cir. 1999).

In particular, the Examiner appears to argue that the knowledge of one skilled in the art, coupled with Janchitraponvej’s teachings, provides the necessary motivation to make the alleged combination. *See, e.g.,* pp. 5-6 of Final Office Action. However, the Examiner’s asserted rationale has no factual or legal basis. Specifically, as the Examiner admits, Janchitraponvej discloses a combination of cationic polymers, polyethyleneimine, and acrylate/acrylamide. This combination provides excellent cleansing of hair while also providing high foaming and conditioning of the hair.

Janchitraponvej, col. 3, lines 52-58. Janchitraponvej, however, does not attribute any favorable properties to the cationic polymer alone, but discloses the properties of its claimed ingredients in combination. Accordingly, Janchitraponvej cannot serve as a

basis for rejecting the present claims, since there is no suggestion or motivation in Janchitraponvej to isolate the cationic conditioning agent from its claimed combination.

Moreover, because neither reference discloses the cationic polymers recited in present claim 51, the Examiner argues that "choosing an appropriate acrylate/acrylamide cationic polymer in the conditioning composition of [Janchitraponvej] would have been obvious for one of ordinary skill in the art because [Janchitraponvej] teaches that cleansing ability is imparted by the cationic nature of the polymers." Final Office Action, p. 4. Applicants, however, have carefully read the reference and have found no statement that Janchitraponvej's acrylate/acrylamide cationic polymers alone impart cleansing ability. Rather, Janchitraponvej touts the advantages of its claimed combination. Thus, under the Examiner's strained rationale, one skilled in the art would have had to decide to use the acrylate/acrylamide copolymer alone, although no such motivation existed to do so, and then choose an appropriate acrylate/acrylamide copolymer, that is not even disclosed in either reference, to incorporate into Kumar's compositions. This is hardly obvious.

Further, imparting improved cleansing properties, such as high foaming and improved conditioning is not even the problem the present inventors sought to solve. Indeed, the present inventors endeavored to provide compositions with improved fixing power. Present specification, p. 1, line 12- p. 2, line 15. The specification discloses that the inventor's compositions provide "good fixing power and good cosmetic properties such as disentangling and styling or brushing of the hair after application" *Id.* p. 2, lines 16-18. Notably, neither reference relied on by the Examiner mentions improved fixing power as a quality its claimed compositions can or did, in fact, improve. In

addition, the present specification discloses that Kumar's compositions had inferior fixing power and the present invention improved upon these compositions. *Id.* at p.1, line 28 - p. 2, line 3.

Thus, the Examiner's proposed combination cannot render the presently claimed invention obvious. Furthermore, Applicants remind the Examiner that the mere fact that the "claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish prima facie obviousness." M.P.E.P. § 2143.01. Rather, the law requires much more. An Examiner must make specific factual findings with respect to a motivation or a suggestion to combine. *In re Lee*, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002). But the Examiner has provided no such findings here. Thus, for at least these reasons discussed above, Applicants respectfully request the withdrawal of this rejection.

B. Cauwet in view of Kumar

The Examiner has also maintained the rejection over claims 33-39, 42, 43, 63, and 67 under 35 U.S.C. § 103(a) as unpatentable over WO 94/21224 to Cauwet et al. ("Cauwet") in view of Kumar.

The Examiner alleges that Cauwet and Kumar both teach hair compositions containing silicone polymers and cationic polymers. Final Office Action, p. 7. Further, she contends that both references recognize that incorporating an aqueous dispersion of a cationic polymer imparts shine, gloss and disentangling properties. *Id.* Based on these teachings, the Examiner concludes "it would have been obvious for one of ordinary skill in the art at the time of the instant invention to incorporate the claimed polysiloxanes of Kumar in the aqueous dispersion [of Cauwet] containing claimed

cationic polymers with an expectation to provide conditioning, brilliance and gloss and hair style retention." *Id.* at 7-8. Applicants respectfully disagree with Examiner's rationale for reasons of record, as well as for the additional reasons below.

Specifically, the Examiner has not demonstrated that the combined references teach or suggest all claimed limitations. In determining whether a rejection is proper, however, the Examiner must consider all words in a claim to determine the patentability of that claim over the prior art. M.P.E.P. § 2143.03. Further, to reject the claim, the Examiner must find each and every limitation recited in the claim in the cited references. *Id.* It appears in the present case, however, that the Examiner has decided to proceed contrary to the M.P.E.P.'s clear instruction. Indeed, she maintains the rejection even though neither reference teaches or suggests the presently claimed "at least one aqueous dispersion of insoluble particles of at least one cationic polymer." Accordingly, the Examiner's rejection is improper.

In particular, the Examiner seemingly finds the teaching of the presently claimed cationic polymers in Cauwet's disclosure of acrylamide homopolymers or a copolymer of cross-linked methacryloxyethyl trimethylammonium. This finding, however, is incorrect; because the Examiner has mischaracterized Cauwet's teachings. Cauwet specifically discloses "a cross-linked acrylamide-methacryloyloxyethyltrimethylammonium chloride copolymer in the form of a dispersion containing 50% by weight of the said homopolymer in *mineral oil*." Cauwet, col. 4, lines 20-23 (emphasis added). Cauwet does not suggest the use of the presently claimed at least one cationic polymer because Cauwet is primarily directed at copolymers in the form of an oil dispersion

while the present invention requires an aqueous dispersion. Thus, the Examiner's reliance on this reference is unwarranted.

Moreover, even if Cauwet were combined with Kumar, the resultant combination would not yield the present invention. The Examiner contends that "Kumar teaches inclusion of cationic, anionic, and amphoteric polymers in combination with polysiloxane polymers . . ." Final Office Action, p. 7. This generic disclosure, however, does not even remotely teach the presently claimed "at least one aqueous dispersion of insoluble particles of at least one cationic polymer." To the contrary, this teaching would render any invention obvious if it disclosed Kumar's claimed polysiloxane with any cationic, anionic, or amphoteric polymer. Given the numerous types and formulations of these polymers, such an overly broad rationale cannot sustain the present rejection. Accordingly, the cited references, alone or combined, do not render the presently claimed invention obvious. Thus, Applicants respectfully request the withdrawal of this rejection.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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